

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 3. In particular, Fig. 3 has been amended to include a component of a disk drive, a magnetic data storage, a slider, a pre-amp, and a micro-actuator, as recited in claims 10 to 14, respectively.

REMARKS

I. INTRODUCTION

Claims 1 to 4 and 6 to 14 are now pending. Reconsideration of the present application in view of the foregoing amendments and following remarks is respectfully requested.

II. OBJECTION TO THE DRAWINGS

The drawings were objected to under 37 C.F.R. § 1.83 (a) for allegedly not showing every feature specified in the claims. In particular, the Office Action asserts that a component of a disk drive, as recited in claim 10, a magnetic data storage, as recited in claim 11, a slider, as recited in claim 12, a pre-amp, as recited in claim 13, and a micro-actuator, as recited in claim 14, must be shown or the features canceled from claims. Applicant does not necessarily agree with the merits of this objection. However, to facilitate matters Fig. 3 has been amended herewith to show these recited features. No new matter has been added. Entry and approval are respectfully requested. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

III. OBJECTION TO THE SPECIFICATION

With respect to the objection of the Specification for allegedly not disclosing a component of a disk drive, a magnetic data storage, a slider, a pre-amp, or a micro-actuator, as recited in claims 10 to 14, the Examiner's attention is respectfully directed to page 1, lines 10 to 13 of the Specification, and to lines 1 to 5 of the Abstract, which discuss these features. Withdrawal of the objection of the Specification is therefore respectfully requested.

IV. REJECTION OF CLAIMS 1, 4, 6 AND 8 UNDER 35 U.S.C. § 103(a)

Claims 1, 4, 6 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Japanese Patent Publication No. 02-17289 ("Kawakami") in view of U.S. Patent No. 5,436,803 ("Annis") and U.S. Patent No. 5,245,613 ("Takami").

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom,

Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Claim 1 relates to an electrostatic discharge device (ESD) safe wireless type of component, which includes a base, an electrically conductive copper trace and an insulation layer, in which a dissipative coating layer applied onto the top of the insulation layer and all connecting cables of ESD sensitive devices.

As admitted on page 4 of the Office Action, the primary Kawakami reference does not in any way disclose or suggest the features of claim 1 with respect to a dissipative coating layer applied onto all connecting cables of ESD sensitive devices. It is also respectfully submitted that the Annis and Takami references do not disclose features of claim 1 with respect to a dissipative coating layer applied onto all connecting cables of ESD sensitive devices. This is evidenced by the fact that the Office Action does not in any way identify the foregoing features in either Annis or Takami. Instead, the Office Action merely asserts on page 4 that “Annis et al., discloses conductive wires connected to a circuit board” and “Takami et al., disclose cable 17 connected to motherboard”, without regard to a dissipative coating layer. Indeed, any review of Annis and Takami makes plain that these references simply do not cure the critical deficiencies of the Kawakami reference with respect to the features of claim 1. It is therefore respectfully submitted that claim 1 is allowable over the references as applied.

The Office Action also asserts that “[a] person of ordinary skill in the art would recognize the advantage of providing antistatic coating to cable connection to have protection against static electricity during the manufacturing process/assembly or during use of the device” and “[t]herefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant’s invention to provide connecting cables to the board of Kawakami et al., for input/output signal of various devices ... and to coat those cable connections with the dissipative coating”, but such assertions are clearly suggestions on the part of the Examiner alone with no supportive basis in the references cited.

In this regard, to the extent that the Examiner maintains the unsupported “ordinary skill” statements regarding those rejections, it is respectfully requested pursuant to 37 C.F.R. § 1.104(d)(2) that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal

knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03). Otherwise, if the Examiner cannot provide either references or an affidavit to support the contentions now made, it is respectfully requested that the rejections of the claims under 35 U.S.C. § 103(a) be withdrawn for this reason alone.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action's generalized assertions that it would have been obvious to modify the references relied upon do not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon.

That is exactly the case here since the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify a reference in view of another reference to provide the claimed subject matter of the claims. Accordingly, the Office Action's assertions in this regard are simply insufficient since the Office must provide proper evidence of a motivation or suggestion for modifying a reference in view of another reference to provide the claimed subject matter.

In short, there is no evidence whatsoever — except subjective speculation — that the references relied upon, whether taken alone, combined or modified, would provide the features discussed above of any of claim 1. It is therefore respectfully submitted that claim 1 is allowable for these further reasons.

Claims 4, 6 and 8 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1.

In sum, it is therefore respectfully submitted that claim 1, and claims that depend from claim 1, including claims 4, 6 and 8, are allowable over the applied references for at least these reasons. Accordingly, the obviousness rejections of these claims should be withdrawn.

V. REJECTION OF CLAIMS 2 AND 3 UNDER 35 U.S.C. § 103(a)

Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as unpatentable over “Kawakami” in view of Annis and Takami, and in future view of U.S. Patent No. 5,350,228 (“Remington”).

With respect to the rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Annis and Takami, and in further view of Remington, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the Remington reference does not cure the critical deficiencies of the Kawakami, Annis and Takami references (as explained above) with respect to claim 1, from which claims 2 and 3 depend. Indeed, the Office Action does not allege that Remington cures the deficiencies of Kawakami, Annis and Takami, as applied against claim 1. It is therefore respectfully submitted that claims 2 and 3 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, withdrawal of the obviousness rejection of claims 2 and 3 is respectfully requested.

VI. REJECTION OF CLAIMS 9 TO 14 UNDER 35 U.S.C. § 103(a)

Claims 9 to 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Annis and Takami, and in further view of U.S. Patent No. 6,459,943 (“Dodsworth”).

With respect to the rejection of claims 9 to 14 under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Annis and Takami, and in further view of Dodsworth, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the Dodsworth reference does not cure the critical deficiencies of the Kawakami, Annis and Takami references (as explained above) with respect to claim 1, from which claims 9 to 14 depend. Indeed, the Office Action does not allege that the Dodsworth cures the deficiencies of Kawakami, Annis and Takami as applied against claim 1. It is therefore respectfully submitted that claims 9 to 14 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, withdrawal of the obviousness rejection of claims 9 to 14 respectfully requested.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn since they have been obviated. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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